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EXAMINER

SHAH, MILAP

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/809,329	<b>Applicant(s)</b> LEVITAN ET AL.	
	<b>Examiner</b> MILAP SHAH	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11, 12, 14-16 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11, 12, 14-16 and 18-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This action is in response to the amendment received June 29, 2009. The Examiner acknowledges that claims 1, 4, 6, 7, & 12 were amended, claims 9, 10, & 17 were canceled, and claims 22-24 were added. Therefore, claims 1-8, 11, 12, 14-16, & 18-24 are currently pending.

### ***Response to Arguments***

Applicant's arguments filed June 29, 2009 have been fully considered but they are not persuasive.

Applicant argues that Emmerson fails to make obvious the arrangement as set out in claim 1. Specifically, Applicant argues that Emmerson is incapable of operating in the claimed manner, such that there is no tracking arrangement that includes a database for tracking use information of a plurality of players with respect to the play of the at least one game and to communicate this use information to the game server over the wireless network when the personal portable device is in communication with the game server as required in the present claims. The Examiner respectfully disagrees and submits that Emmerson in view of common knowledge in the art makes obvious Applicant's claimed invention, including the updated or added subject matter.

Applicant has added that the at least one additional game has "a tracking arrangement including a database for tracking use information of a plurality of users on said device". Emmerson as modified and discussed in the previous rejection, discloses a tracking arrangement including a database (i.e. memory on the cellular phone) for tracking use information of a plurality of users on the device (figure 4, step 260, where Emmerson discloses the server sends a message including the updated ranking or league table having updated high scores information to the player, this information includes use information, such as high scores, for a *plurality* of users, where this information is saved on the memory of the cellular phone).

The Applicant further argues that Emmerson teaches away from a personal portable device which can operate in a local mode and provide data manipulation as Emmerson outlines the advantages of the server performing data manipulation, such as the mobile phone's limited memory is not taken up with performing such tasks. The Examiner respectfully disagrees and submits that such limitations of the Emmerson devices does not explicitly preclude the device being capable of performing such tasks, rather it appears Emmerson merely indicates that it may be beneficial that the server performs the data manipulation. Nonetheless, a skilled artisan improving upon Emmerson to include both a local mode and registered mode, would have found it common practice to determine the necessary hardware requirements to implement such a device having both the local and registered mode. The Examiner submits again that a local mode, such as a local high scores list is notoriously well known in the art and numerous gaming applications across a number of gaming terminals have included high scores lists for decades. Applicant requested teaching references, and the Examiner has submitted at least two teaching references as listed in the updated rejection below. Implementing both modes appears to require mere routine skill in the art, such that no unexpected result appears to be achieved.

The Applicant also argues that there is no provision in the Emmerson reference of tracking of use information of a plurality of users of a downloaded game in a database of the downloaded game as set out in the present application. The Examiner respectfully disagrees. Applicant's invention as made obvious over Emmerson in view of common knowledge in the art (i.e. a local mode) appears to disclose a similar "database" or memory in the cellular phone including a high scores list as is commonplace in a plethora of games (as evidenced in view of Applicant's request). Using a similar structure, the Emmerson device would be capable of providing both the local and registered mode, allowing players to repeatedly play games in a local mode, storing their scores under any desired username or alias, as is commonplace and evidenced by the references submitted. Improving Emmerson to include the local mode, sets forth a "database" for

Art Unit: 3714

tracking use information for a plurality of players, as any player may add their desired username to a high scores list. For instance, traditional arcade games as notoriously old and well known in the art to include high scores lists, where patrons attempt to obtain a high score which is displayed on the game device. The devices kept a local database tracking use information for a plurality of users. A skilled artisan would have possessed the common knowledge and ordinary skill to correlate a similar local mode to mobile games. Moreover, the skilled artisan improving upon Emmerson, would have found it obvious to include that same local mode and Emmerson's registered mode simultaneously, allowing players to practice in a local mode and compete globally in the registered mode.

Applicant's amendments and remarks to some dependent claims are noted. The Examiner has updated the rejections accordingly to include the newly added or amended subject matter. For at least these reasons, the rejections of the pending claims as made obvious over Emmerson are either maintained or updated in view of the amendments.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-7, 11, & 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmerson (U.S. Patent Application Publication No. 2002/0103019; of record).

**Claim 1:** Emmerson discloses the invention substantially as claimed including a personal portable device (i.e. mobile or cellular telephone – paragraph 0002) to be carried by a user and having a primary practical function (i.e. to make telephone calls) and a secondary personal entertainment

function (i.e. to play games), the primary practical function including the capability to communicate over a wireless communication network with a separate computer (figure 2 & paragraph 0022), the secondary personal entertainment function includes a series of downloadable games downloaded to the personal portable device using the communication capability of the primary practical function to form a wireless connection with a game server computer and have the game server computer download at least one additional game, the at least one additional game including as part thereof a tracking arrangement including a database (i.e. memory) for tracking usage information of a plurality of users on the device with respect to the play of the at least one game and to communicate the use information to the game server computer over the wireless communication network when the personal portable device is in communication with the game server computer (see at least paragraphs 0022-0026, 0032-0033, & 0040-0041), the at least one game being operable to receive from the game server computer when the personal portable device is in communication with the game server collective results for said at least one game of other personal portable devices including high scores and collective high score ranking information (paragraphs 0040-0041, where Emmerson discloses that game server receives scoring information from each of a plurality of players, updates a league table with the standings of each player and informs the player where he stands in the league table, thus collective use information is obtained and a high scores and ranking is provided).

Emmerson appears to lack an explicit disclosure that the game is selectively playable in a local mode and a registered mode where each mode includes game summary information maintained on the personal portable device including a series of high scores for a plurality of collective users, the high scores in the local mode accepting any identified user and the high scores

Art Unit: 3714

in the registered mode requiring each user to be registered with the game server, where the high scores are uploaded to the game server from the personal portable device.

Nonetheless, the Examiner submits that (1) a local mode for a game device is notoriously well known in the art; and (2) Emmerson reasonably discloses the registered mode in which registered players upload their scores to a game server; thus, it would have been an obvious matter to modify Emmerson to operate in either mode based on game play, high score achieved, or selection by the player.

As to (1) above, it is notoriously well known in the art for devices having games playable thereon, such as mobile phones, arcade games, gaming consoles, personal computers, and the like, to offer a local mode where any username desired may be entered by a player when a score eligible for the high scores list is achieved in the game. Such a 'high scores' list or leader board is a well known concept in the gaming arts and has been employed in a plethora of games on various platforms and devices and the like for decades. The Examiner will furnish a teaching reference for the well known concept of the 'local mode' as claimed upon Applicant's request. Regardless, those skilled in the art would recognize such a mode is common practice in the art. As requested by Applicant, see at least U.S. Patent Application Publication No. 2003/0093168 to Nagaoka (see at least figure 3 and the related description thereof, further figures 7A-7D depict mobile game application screens, where at least local ranking information is a game menu option for display of a local high scores list) and U.S. Patent No. 6,709,335 to Bates et al. (column 19, lines 40-62), each teaching at least a local mode in which a local high scores is maintained for a mobile gaming application. Accordingly, a "local mode" appears *prima facie* obvious and a skilled artisan would have had good reason to pursue the addition of a local mode to Emmerson for at least the reason

to allow players to practice or simply play games for enjoyment without competing against other players or submitting their scores to a server.

Next, as to (2) above, Emmerson discloses a modern age of competition based on high scores in a game, whereby instead of being limited to compete against friends or family local to the game device, a player enjoys the excitement of competing globally with anyone that has the same game. Emmerson discloses a user initially registers with the game server, or if the player has previously registered, allowing the player to participate in gaming activities such as downloading games, submitting scores, receiving collective scores, or the like (paragraphs 0025-0026). Thus, Emmerson essentially appears to disclose a registered mode requiring each user being registered with the game server and their score being uploaded to the game server. Emmerson appears to suggest that scores be uploaded to a game server for the purpose of competition. In a similar version of Emmerson, it would have been an obvious matter to merely upload game scores and maintain a global 'list' of scores in a single-player type game, as 'the game' referenced is an obvious design consideration. For instance, a single player game such as the old and well known Tetris operable in a registered mode merely allows a player to submit their score to an online leader board or list of high scores so that others can see their registered name associated with a score. Such a version does not appear to discourage any players as anyone may obtain a high score and add their registered name to the high scores list.

Consequently, given the teachings of Emmerson combined with a well known 'local mode' as claimed, it would have been obvious to one of ordinary skill in the art to modify Emmerson to allow play of particular games in a local mode for the purpose of allowing the player to practice or simply play for enjoyment, and further allow a player to play the game in the registered mode competing against other players globally, after they've had the opportunity to practice and enhance



their skills. Furthermore, in a broad sense, Applicant's claimed local mode and registered mode may be correlated to well known "single player" and "multi-player" modes in a vast plethora of known games. For instance, certain known games having a single player mode allow a player to play whichever game it may be in a single player mode allowing the player to enhance their skills. These known single player modes are also known to include a high scores list for single player play or 'local play'. Similarly, the multi-player play as is known in one embodiment, allows for players to play over a network against non-local players, which normally requires a registered name, where the registered mode also includes a global high scores list of all playing in the multi-player mode. It should also be noted that 'the game' referenced above need not necessarily be any particular game referenced within Emmerson, that is, any compatible game or game type may be employed on the personal portable device of Emmerson, thus, Tetris as discussed above may be played in a local or single player mode (i.e. game play with local high scores) or in a registered or multiplayer mode (i.e. same game in which resultant scores are compared globally). Therefore, a specific local mode and specific registered mode each having their own collective series of high scores does not appear to patentably distinguish over the known prior art and common practice in the art.

**Claim 3:** Emmerson discloses mobile gaming, where the mobile gaming is carried out on a wireless telephone device, such as a mobile or cellular phone, said phone is in wireless communication to access and communicate with a game server (figure 2 & paragraph 0002).

**Claim 4:** Emmerson discloses a web browser application as being present on the mobile phone (paragraph 0024). Emmerson also discloses a subscription/registration process, whereby a player must have initially subscribed or registered to the game server to participate in multiplayer games through the game server. Thus, upon connection to the game server, the server performs an authentication process to determine if the player has previously subscribed and has access to the

game server. If yes, access is granted and the game selection process continues. However, if no subscription is determined, the player is denied access and alternatively provided with instructions on how to register/subscribe and pay the necessary fees to access the game server. Further, for purposes of filling out a registration or subscription form, the browser on the mobile phone must be utilized, thus, Emmerson discloses allowing a user to initially register with the game server, or if the player has previously registered, allowing the player to participate in gaming activities such as downloading games, submitting scores, receiving collective scores, or the like (paragraphs 0025-0026).

**Claim 5:** Emmerson discloses that at block 260 (figure 4), the server downloads an updated league table with collective use information to the player's mobile phone, where such information is selectively displayable when the player wishes to view his standings in the league table (paragraph 0041).

**Claim 6:** Clearly there must be a display function to use the mobile phone's LCD (paragraph 0002) to display game information such as collective use information, amongst other information. Emmerson discloses a game menu (paragraph 0008), and discloses that the display includes at least collective game use information received from the game server computer (paragraph 0041 and figure 4[step 260], where the user is informed of his standing in the scores list, which must be displayed on the device).

**Claim 7:** Emmerson discloses a series of games being downloaded to the mobile phone (paragraph 0041, where Emmerson discloses upon a player submitting a new game outcome or result, the game server could send out the next fixture or level in the competition, where the competition has multiple games, fixtures, levels, or the like, thereby being a series of downloaded games). It would have been obvious to a skilled artisan to explicitly use common game menus (i.e.

similar themes or the like) for allowing a user to access game use information. Additionally, as each next fixture or level may be sent out as the series of games, it would appear implicit that each fixture or level of a common game would include common game menus.

**Claim 11:** Emmerson discloses the personal portable device is a mobile or cellular telephone, as discussed above, which may be interpreted as a personal data assistant as a mobile phone assists in personal data (i.e. address book). Emmerson discloses the personal data assistant is connected to operator server (figure 2[server 42]), which relays communication to the game server (figure 2[server 31]) connected to the operator server.

**Claim 18:** Emmerson discloses the at least one game is operable in a tournament for fame mode where the game server computer receives and processes game result from a group of personal portable devices (paragraph 0008).

**Claim 19:** See the rejection of claim 3.

**Claims 20 & 21:** Emmerson as modified and discussed above with respect to claim 1 teaches that a player would have access to both high scores list in the local mode or in the registered mode, such that it would be an obvious matter that the 'game' in local mode allows access to high scores for registered mode (i.e. even if the player is not registered, downloading of a known global high scores list is an obvious design consideration).

**Claim 22:** Emmerson as modified makes obvious the local mode as discussed above, where the local mode includes a high scores game screen. Emmerson does not explicitly disclose the game screen includes an icon for accessing high scores for the registered mode, however, such graphical user interface limitations here are merely functional limitations presented in an apparatus claim, thus, the Examiner submits that the display screen of the game device as taught by Emmerson as

Art Unit: 3714

modified is capable of displaying a game screen in a local mode including an icon for accessing high scores for the registered mode.

**Claim 23:** As discussed above, Emmerson discloses game menus, such as to navigate various game options. Emmerson explicitly lacks a login screen, however, given Emmerson as modified including both a local mode and a registered mode, it would have been notoriously obvious to a skilled artisan to include a login screen to allow a player to access the registered mode or play in a local mode as a guest or any desirable alias. Given the discussion of a local mode and registered mode, it appears *prima facie* to allow the user to select which mode and login if necessary.

**Claim 24:** Emmerson discloses a game menu option (i.e. a request to see high scores) that when actuated causes the device to obtain from the game server computer high scores for the at least one game based on registered users and store the high scores in the database and display the high scores on the device when initiated by the user (paragraph 0024, 033, and 0040-0041, where Emmerson discloses game menus and receiving high scores for registered users, which must be saved in at least the devices memory or "database").

Claims 2, 8, 12, & 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmerson, as applied to claims 1, 3-7, 11, & 18-24, where applicable, in view of Acres (U.S. Patent Application Publication No. 2001/0034643).

**Claims 2, 8, 12, 14, & 16:** Emmerson discloses the invention substantially as claimed except for explicitly disclosing a sweepstakes mode, the sweepstakes mode being based on various gaming activities such as an entry for each time at least one game is played and communicated to a game server during a predetermined time period, an entry for registration and the number of times the eligible games are played and communicated to the game server, or an entry each time a game in

Art Unit: 3714

the sweepstakes mode is simply played. Regardless of such a deficiency in Emmerson, those of ordinary skill in the art would have found such a sweepstakes mode to be a notoriously well known option in the gaming arts for implementation in a variety of gaming applications. Specifically, the Examiner submits that Acres explicitly teaches a sweepstakes mode of gaming in which an advertisement system may provide an incentive for a user to play a game and view advertisements by offering rewards such as entries to sweepstakes based on a variety of gaming activities, such as a user who completes a game within a certain period of time, a user who has one of the 10 highest scores, or a user who has one of the longest winning streaks may receive this additional reward (paragraph 0018). While Acres is directed to casino gaming using gaming terminals (i.e. slot machines or the like), the teachings of Acres appear applicable in a variety of different gaming applications (i.e. mobile gaming, computer gaming, console gaming, etc.). Given Acres teachings, one skilled in the art would have found it obvious to implement a sweepstakes mode in the mobile games played within the Emmerson invention to benefit both the players (i.e. providing additional ways to win – a sweepstakes drawing) and the gaming hosts (i.e. additional revenue from advertising sponsors). The concept of advertising and providing additional awards, such as sweepstakes entries or raffle tickets, has been notoriously well known in the art for some time, and upon Applicant's request the Examiner will submit numerous additional prior art literature that discusses these types of marketing techniques to attract more players and generate higher revenues for gaming hosts. Acres, as seen in figure 1, has four portions of the game screen dedicated to advertisements, and as is known in the marketing industry, advertisements are not cheap, thus clearly the gaming hosts are generating a plentiful revenue stream from these advertisements. Consequently, the gaming hosts are able to offer a wide variety of additional bonuses or rewards to players for their loyalty and game play. Therefore, for at least the reasons provided, it would have

been obvious to one of ordinary skill in the art at the time the invention was made to modify Emmerson to implement a sweepstakes "mode" of the mobile games applications. Further, it would have been obvious to base the individual entries off a plethora of possible measurable gaming activities including those discussed above, for at least the reason that if Acres provides sweepstakes entries for such activities as obtaining a high score, it would be art recognized equivalents to base sweepstakes off additional obvious variants - basically, it appears any gaming activities that could be monitored or measured in some way could be used by a game designer to implement the known sweepstakes mode based on said gaming activities. Regarding claims 12 & 16, as previously explained, Emmerson discloses downloading a plurality of games, where in view of Acres, at least some of the games having game menu options to allow play of said games in a sweepstakes mode.

**Claim 15:** Emmerson discloses mobile gaming, where the mobile gaming is carried out on a wireless telephone device, such as a mobile or cellular phone, said phone is in wireless communication to access and communicate with a game server (figure 2 & paragraph 0002).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Applicant is directed to the attached "Notice of References Cited" for additional relevant prior art. The Examiner respectfully requests the Applicant to fully review each reference as potentially teaching all or part of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MILAP SHAH whose telephone number is (571)272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MBS/

/Peter D. Vo/  
Supervisory Patent Examiner, Art Unit 3714